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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,875	05/02/2001	Kunihiko Yano	Q64302	5307

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/830,875	Applicant(s) YANO, KUNIIKO	
	Examiner Patricia L. Nordmeyer	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-39 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 28-33 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☒ Claim(s) 34-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 34 – 39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new claims are directed towards a new invention of a portable apparatus, which requires a new and different search.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34 – 39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Withdrawn Rejections

2. The 35 U.S.C. 112 rejection of claim 28 is withdrawn due to Applicant's amendment in the paper dated March 3, 2004.

Repeated Rejections

3. The 35 U.S.C. 103 rejection of claims 28 – 32 over Taniguchi in view Friedman are repeated for the reasons previously of record.

Taniguchi discloses an optical article that uses a resin substrate (Column 2, lines 65 - 68

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and Column 9, lines 42 - 452) as part of an optical article. An antireflection film (coating) is formed on the outside of the substrate (Column 18, lines 1 - 3). Before placing the antireflection coating on the substrate, a hard coat film is placed on the substrate (Column 9, lines 53 - 57 and Column 18, lines 20 - 22). A film that is formed by coating and curing contains silica (silicon oxide) particles with diameters between 1 to 200 nm (Column 3, lines 22 - 23) and an organic silicon compound with hydrolysable groups (Column 3, line 52 to Column 5, line 15) forms the hard coating. Both the anti-reflection coating and the hard coating film are formed on both the inner and outer surfaces of the cover glass substrate (Column 14, lines 8 - 9). The antireflection film can have a decorative part by dyeing the film (Column 9, lines 57 - 61). The surface of the antireflection is treated to give it oil and water repellent characteristics (Column 2, lines 37 - 40). However, Taniguchi fails to disclose an anti-reflection coating formed on the inner surface of the cover glass substrate without the hard coating film interposed between them.

Friedman teaches a transparent substrate, lens, (Column 3, lines 56 - 59) having a concave surface (Figure 2) made from thermoplastic resin material (Column 5, lines 7 - 11) with an antireflection coating formed on the inner and outer surfaces of the lens without a hard coat film (Column 5, lines 47 - 50 and Column 14, lines 32 - 33) in a lens for the purpose of making an optical article that may be used for a variety of different activities including athletics, training and display terminals.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the an optical article with a hard coat film and

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antireflection coating on the outer surface and an antireflection coating on the inside surface with a film base in Taniguchi in order to make an optical article that may be used for a variety of different activities including athletics, training and display terminals as taught by Friedman.

The limitations of the hard coating film is an organic thin film transferred from a transfer foil in claim 29, the anti-reflection coating undergoing water and oil repellent treatment in claim 32 and the anti-reflection coating having a decorative part by printing in claim 31 is a process limitation. The determination of patentability for a product claim with a process limitation is based on the product itself and not on the method of production. In this case, the limitations of the organic thin film transferred from a transfer foil, the anti-reflection coating undergoing water and oil repellent treatment and the decorative part formed by printing are methods of production and therefore does not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

Regarding the limitation of the cover being used to cover the view plane of a liquid crystal display placed in a housing of a portable apparatus and to make visible the view plane of the display unit in claim 17 and the limitation of the cover being used to cover the view plane of a liquid crystal display placed in a housing of a portable apparatus and to make visible the view plane of the display unit through a gap between the cover glass and view plane of the liquid crystal display in claim 28, it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure

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is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Although claim 28 claims a gap between the cover glass and liquid crystal display, the gap does not add to the structure of the cover glass itself but is directed towards the how the glass would be used in combination with the liquid crystal display.

New Rejection

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi (USPN 4,765,729) in view of Friedman (USPN 6,159,397) and further in view of Mase et al. (USPN 5,693,366).

Taniguchi, as modified with Friedman, discloses the claimed cover glass except for the primer layer being interposed between the cover glass substrate and the hard coating film.

Mase et al. teaches a primer layer formed from thermosetting polyurethane against the plastic substrate and covered with the hard coat layer (Column 4, lines 21 – 23 and Column 5,

lines 16 – 30) in an optical article that uses a resin substrate (Column 2, lines 32 - 35) as part of an optical lens for the purpose of making a lens that has greater resistance to impact.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the polyurethane resin primer in the modified Taniguchi in order to have a lens that has greater resistance to impact as taught by Mase et al.

Response to Arguments

6. Applicant's arguments filed March 3, 2004 regarding the rejection of claims 28 – 33 have been fully considered but they are not persuasive.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Friedman and Taniguchi both teach lens that are coated with materials. The Friedman reference does not refer to the presence of a hard coating and broadly claims the coating of the antireflection layers wherein the can be coated on both the inner and outer surfaces of the lens (Column 14, lines 32 – 33).

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the gap) are not a structural limitation of the article recited in the rejected claims. Although the claims are

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interpreted in light of the specification, the gap formed in the article is a combination of a portable apparatus and cover glass, which is being claimed by the applicant.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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pln

[Signature]
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/22/04